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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,353	11/14/2003	Benjamin H. Malka	05793.3114	1450
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/712,353

Applicant(s)

MALKA ET AL.

Examiner

Ella Colbert

Art Unit

3696

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 32-47 and 63-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 32-47, 63-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-16, 32-47, and 63-78 are pending. Claims 1, 32, and 63 have been amended and claims 17-31, 48-62, and 79-83 have been cancelled. This communication file 09/30/08 entered as Response After Non-Final Action and Request for Extension of Time.
2. The 35 USC 112, second rejections for claims 1-16 still remain as set forth here below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "receiving a plurality of individual funds ...; ... determining a first portion of the aggregated fund ..., ..., ...". It is unclear who or what is performing the "receiving" and the "determining" steps. Is the user doing the "receiving" and the "determining" or is a computer doing the "receiving" and the "determining"?

Claims 2-16 are also rejected for their dependency from a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 32, and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 5,297,026) Hoffman.

Claim 1. Hoffman discloses, A method, performed by a processor, for funding a financial institution through a financial investment fund, the method comprising:

receiving a plurality of individual funds corresponding to a plurality of investors respectively (col. 2, lines 32-47); aggregating the plurality of individual funds into an aggregated fund for investing into the financial investment fund, wherein the financial investment fund includes a plurality of certificates of deposits and a transaction account (col. 2, lines 57-68); determining a first portion of the financial investment fund to invest in the certificates of deposits issued by the financial institution, wherein each certificate of deposit matures at a predetermined time, and wherein the financial institution uses the first portion of the financial investment fund to perform a function of the financial institution (col. 3, lines 1-26 and col. 4, lines 54-61); and determining, based on the amount of the first portion invested in the certificates of deposits, a second portion of the financial investment fund for investing in the transaction account (col. 3, lines 1-26 and col. 4, lines 54-61).

Claim 32. Hoffman discloses, A system, performed by a processor, for funding a financial institution through a financial investment fund, the system comprising:
a component for receiving a plurality of individual funds corresponding to a plurality of investors respectively (col. 2, lines 32-47); a component for aggregating the plurality of

individual funds into an aggregated fund for investing into the financial investment fund, wherein the financial investment fund includes a plurality of certificates of deposits and a transaction account (col. 2, lines 57-68); a component for determining a first portion of the financial investment fund to invest in the certificates of deposits issued by the financial institution, wherein each certificate of deposit matures at a predetermined time, and wherein the financial institution uses the first portion of the aggregated fund to perform a function of the financial institution(col. 3, lines 1-26 and col. 4, lines 54-61); and a component for determining, based on the amount of the first portion invested in the certificates of deposits, a second portion of the financial investment fund for investing in the transaction account (col. 3, lines 1-26 and col. 4, lines 54-61).

Claim 63. Hoffman discloses, A computer-readable medium on which is stored a set of instructions for funding a financial institution through a financial investment fund, which when executed perform stages comprising: receiving a plurality of individual funds corresponding to a plurality of investors respectively(col. 2, lines 32-47); aggregating the plurality of individual funds into an aggregated fund for investing into the financial investment fund, wherein the financial investment fund includes a plurality, of certificates of deposits and a transaction account (col. 2, lines 57-68); determining a first portion of the financial investment fund to invest in the certificates of deposits issued by the financial institution, wherein each certificate of deposit matures at a predetermined time, and wherein the financial institution uses the first portion of the financial investment fund to perform a function of the financial institution (col. 3, lines 1-26 and col. 4, lines 54-61); and determining, based on the amount of the first portion

invested in the certificates of deposits, a second portion of the financial investment fund for investing in the transaction account (col. 3, lines 1-26 and col. 4, lines 54-61).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-14, 33-45, and 64-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,297,026) Hoffman in view of (US 4,985,833) Oncken .

Claims 2, 33, and 64. Hoffman failed to disclose, wherein the second portion is used when an investor requests liquidation of funds invested in at least one certificate of deposit at a time before the certificate of deposit matures. Oncken discloses, wherein the second portion is used when an investor requests liquidation of funds invested in at least one certificate of deposit at a time before the certificate of deposit matures (col. 2, lines 10-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Oncken in Hoffman because such an incorporation would allow Hoffman to have the interest rate fixed for the term of the certificate of deposit and to have penalties assessed for early withdrawal.

Claims 3, 34, and 65. Hoffman discloses, further comprising paying a return to the plurality investors from the financial investment fund (col. 4, lines 30-53).

Claims 4, 35, 66. Hoffman discloses, wherein one of the at least one financial institution manages the financial investment fund (col. 5, line 55-col. 6, line 15).

Claims 5, 36, and 67. Hoffman discloses, wherein the plurality of certificates of deposits have at least one of varying return rates and varying maturity dates (col. 3, lines 1-12).

Claims 6, 37, and 68. Hoffman discloses, wherein the plurality of certificates of deposit include at least one of jumbo certificates of deposits, promissory notes, time deposits, and bonds (col. 2, lines 57-68).

Claims 7, 38, and 69. Hoffman discloses, wherein the function of the financial institution comprises a credit card operation (col. 2, lines 32-47).

Claims 8, 39, and 70. Hoffman discloses, The method of claim 7, wherein the financial institution uses the first portion of the aggregated fund to pay merchants for goods or services provided to users of credit cards provided by the financial institution (col. 5, line 33-col. 6, line 15).

Claims 9, 40, and 47. Hoffman failed to disclose, wherein at least a portion of the plurality of individual funds is insured by the United States federal government. Oncken discloses, wherein at least a portion of the plurality of individual funds is insured by the United States federal government (col. 1, lines 12-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Oncken in Hoffman because such an incorporation would allow Hoffman to have funds in accounts insured to \$100,000 or more if the amount over \$100,000 is placed in other accounts such as money market, certificates of deposit (cd's) or savings accounts or mutual funds or 401K's or bonds.

Claims 10, 41, and 72. Hoffman and Oncken failed to disclose, wherein the financial investment fund is configured to allow at least one of the plurality of investors to withdraw from the financial investment fund at any time regardless of maturity dates of any of the plurality of certificates of deposits. It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow at least one of the plurality of investors to withdraw from the financial investment fund at any time regardless of maturity dates of any of the plurality of certificates of deposits because deposits are of a temporary nature and will be relocated based entirely on rate.

Claims 11, 42, and 73. Hoffman failed to disclose, wherein the transaction account is used to pay for withdrawals from the financial investment fund. Oncken discloses, wherein the transaction account is used to pay for withdrawals from the financial investment fund (col. 6, lines 18-35). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the teachings of Oncken in Hoffman because such an incorporation would allow Hoffman to have withdrawals as needed without any limit on the number of withdrawals from the account.

Claims 12, 43, and 74. Hoffman discloses, wherein the amount in the transaction account is established to cover no more than an expected amount of the withdrawals from the financial investment fund over a given amount of time (col.2, lines 26-31).

Claims 13, 44, and 75. Hoffman discloses, wherein a yield received by an enterprise managing the financial investment fund on the plurality of financial instruments is greater than a yield received by the enterprise managing the financial investment fund on funds in the transaction account (col. 5, line 32-col. 6, line 26).

Claims 14, 45, and 76. Hoffman and Oncken failed to disclose, wherein the financial investment fund is used in conjunction with at least one of an individual retirement account and a 401K account. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the financial investment fund used in conjunction with an individual retirement account and a 401K account because this would allow for another means of investment for an individual who is planning for retirement.

Claims 15, 16, 46, 47, 77, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,297,026) Hoffman in view of (US 4,985,833) Oncken and further in view of (US 5,987,436) Halbrook.

Claims 15, 46, and 77. Hoffman and Oncken failed to disclose, wherein providing the financial investment fund comprises communicating over a network. Halbrook discloses, wherein providing the financial investment fund comprises communicating over a network (col. 3, lines 53-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Halbrook in Hoffman and Oncken because such an incorporation would allow Hoffman and Oncken to make deposit and to move investments around in different investments by using a network.

Claims 16, 47, and 78. Hoffman and Oncken failed to disclose, wherein user devices on the network are located in at least one of a home, an office, a store, a retail center

kiosk, an office of at least one of the at least one financial institution, and an office of an enterprise managing the financial investment fund. Halbrook did not expressly disclose where his system is located in col. 3, lines 45-62. The method, system, and computer readable medium is performed in the same manner regardless of the location. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 1031 (Fed. Cir. 1994).

Response to Arguments

Applicant's arguments filed 09/30/08 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' Argue: The Examiner alleges that "[i]t is unclear who or what is performing the 'receiving' and the 'determining' steps and Applicants' traverse the rejection because claim 1 recites "[a] method, performed by a processor" and therefore, the individual steps of the method claims 1-16 are performed by a processor has been considered but is not persuasive. Response: No longer is a processor in the preamble considered acceptable. There must be a computer in the body of the claim to perform the step(s) according to the following recent court cases: Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or

permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972). If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101. In this particular case regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class.

Issue no. 2: Applicants' argue: Hoffman fails to teach or suggest at least aggregating the plurality of individual funds into an aggregated fund for investing into the financial investment fund, wherein the financial investment fund includes a plurality of certificates of deposits and a transaction account and the determining steps, as recited in amended claim 1 has been considered but is not persuasive. Response: It is interpreted that Hoffman discloses "... investing into a financial investment fund with the financial investment fund including a plurality of certificates of deposits and a transaction account in col. 2, line 57-col. 3, line 45.

Issue no. 3: Applicants' argue: Oncken and Halbrook do not cure the noted deficiencies of Hoffman not does the Examiner rely on Oncken and Halbrook for such teachings have been considered but are not persuasive. Response: Oncken was relied upon for disclosing or suggesting the claim limitations of claims 2, 9, 11, 33, 40, 42, 47, 64, and 73 and Halbrook was relied upon for disclosing or suggesting the claim limitations of claims 15, 16, 46, 47, 77, and 78.

"Claims in a pending application should be given their broadest possible interpretation". In re Pearson, 181 USPQ 641 (CCPA 1974).

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

"Nilssen urges this court to establish a "reality-based" definition whereby, in effect, references may not be combined to formulate obviousness rejections absent an express suggestion in one prior art reference to look to another specific reference. We reject that recommendation as contrary to out precedent which holds that for the purpose of combining teachings, those references need not explicitly suggest combining teachings, much less specific references". See, e.g., *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983); *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Also see, *In re Nilssen* (CAFC) 7 USPQ2d 1500 (7/13/1988).

It is noted that Applicants' were silent regarding the Examiner's taking of Official Notice. MPEP 2144.02 states "If Applicant does not traverse the Examiner's assertion of official notice or Applicant's traverse is not adequate, the Examiner should clearly indicate in the next Office Action that the common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant either failed to traverse the Examiner's assertion of Official Notice or that the traverse was inadequate. If the traverse was inadequate, the Examiner should include an explanation as to why it was inadequate."

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

January 21, 2009

Application Number**Application/Control No.**

10/712,353

Examiner

Ella Colbert

**Applicant(s)/Patent under
Reexamination**

MALKA ET AL.

Art Unit

3696